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KUBOVCIK & KUBOVCIK  
SUITE 1105  
1215 SOUTH CLARK STREET  
ARLINGTON, VA 22202

EXAMINER
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TOSCANO, ALICIA

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TOSHIAKI KIMURA, SHUICHI NONAKA,  
TAKASHI OCHI, TAKAAKI SAKAI,  
KATSUHIKO MOCHIZUKI, and  
YUHEL MAEDA

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Appeal 2009-013597  
Application 10/525,092  
Technology Center 1700

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Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and  
PETER F. KRATZ, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1 and 5-31. We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

Appellants claim polylactic acid fiber comprising a polylactic acid containing fatty acid bisamide and/or alkyl-substituted fatty acid monoamide having a melting point of 100°C or higher, wherein the fiber is produced by a melt-spinning method (claim 1).

Further details of this claim subject matter are set forth in representative claim 1 which reads as follows:

1. Polylactic acid fiber comprising a polylactic acid containing fatty acid bisamide and/or alkyl-substituted fatty acid monoamide in an amount of 0.1 to 5 weight % in relation to the whole of fiber, said fatty acid bisamide and alkyl-substituted fatty acid monoamide having a melting point of 100°C or higher, wherein said fiber is produced by a melt-spinning method and has a  $b^*$  value in fiber color system of  $L^*a^*b^*$  in the range of -1 to 5 and a single fiber fineness of 0.1-10 dtex, and the fiber-constituting polylactic acid is 40 eq/t or less in carboxyl end group amount.

The Examiner rejects claims 1, 5-11, 16, 19, 20, 21, 23, and 26-31 under 35 U.S.C. § 103(a) as being unpatentable over Nishimura (JP 2001-131827, published May 2001; as translated) or Obuchi (US Patent 6,417,294 B1, issued July 2002) in view Tan (W02/12395 published February 2002 wherein US Patent 6,710,135 B2, issued March 2004, is used as an equivalent English document) and further in view of Kondo (US Patent 5,593,778, issued January 1997) and Zeitler (US Patent 5,811,508, issued September 1998). The Examiner correspondingly rejects the remaining

claims on appeal over these references and further in view of other prior art of record.

Appellants do not separately argue any of the dependent claims on appeal including the separately rejected dependent claims. Accordingly, all of the claims under rejection will stand or fall with sole independent claim 1.

We will sustain the Examiner's rejections with the reasons expressed in the Answer and below.

It is undisputed that Nishimura and Obuchi respectively discloses flat yarn and extruded filament comprising polylactic acid in combination with lubricants/nucleating agents which include the amides defined by claim 1. Although Nishimura and Obuchi do not disclose using their polylactic acid composition in a melt-spinning method, the Examiner correctly finds that Tan discloses using a similar composition (i.e., an unidentified lubricant in combination with polylactic acid having molecular weights in the ranges disclosed by Nishimura and Obuchi) in a melt-spinning method. In light of these facts, we share the Examiner's conclusion that it would have been obvious to use the polylactic acid compositions of Nishimura or Obuchi for preparing a melt-spun polylactic acid fiber. For the reasons detailed in the Answer, we also agree with the Examiner that it would have been obvious to provide this melt-spun fiber with the degree of fineness required by claim 1 in view of Kondo and with the carboxyl end group amount required by claim 1 in view of Zeitler.

Appellants argue that the Examiner's obviousness conclusion is incorrect because a person of ordinary skill in the art would not have had a reasonable expectation that fibers having the claim 1 fineness of 0.1-10 dtex

could be successfully produced from the compositions of Nishimura or Obuchi by melt spinning (App. Br. 6-15, 19).

This argument is unpersuasive.

As indicated above and detailed in the Answer, the similarities of Tan's polylactic acid compositions to the polylactic acid compositions of Nishimura or Obuchi would have given one with ordinary skill in this art a reasonable expectation that the latter compositions would be successful when used for producing fine filaments in the melt-spinning method disclosed by Tan.

Appellants attempt to support their argument by pointing to Nishimura's disclosure that fibrillation occurs in flat or tape yarns having a fineness less than 500 dtex (*id.* at para. bridging 9-10). However, as later acknowledged by Appellants, while a flat yarn is prone to undergo fibrillation, a melt-spun fiber is not (*id.* at 11-12).

As further support for their argument, Appellants rely on the Mochizuki § 132 Declaration of record which shows that good results were not obtained when melt-spinning the compositions of Nishimura's examples 1-3 (*id.* at 13-14). For a number of reasons, Appellants' reliance on this Declaration is misplaced. First, the Declaration does not explain why the results obtained with Nishimura's example compositions are relevant to the compositions of Obuchi. Second, the Declaration does not explain why no reasonable expectation of success for melt-spinning the Nishimura and Obuchi compositions is shown by the mere fact that the exemplified compositions of Nishimura do not yield good melt-spinning results. For all we know based on this record, these melt-spinning results though perhaps not "good" nevertheless yielded acceptable melt-spun fibers. Third, the

Declaration does not explain why Declarant's automatus melt-spinning of Nishimura's example compositions should be considered to represent the efforts that would have been made by one with ordinary skill in the art to successfully obtain a melt-spun polylactic acid fiber. In this regard, it is an established principle that "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

Appellants additionally argue that the prior art applied against claim 1 fails to disclose or suggest the properties resulting from use of the claimed fatty acid amides in the melt-spinning of polylactic acid (App. Br. 15-20).

We are unconvinced by Appellants' argument.

We agree with the Examiner that the  $b^*$  value range defined by claim 1 would be a property inherently processed by the above discussed compositions of Nishimura and Obuchi since these compositions correspond to the claim 1 compositions (Ans. 14). At most, Appellants have merely discovered that these prior art compositions possess the  $b^*$  values of claim 1. However, "[t]he discovery of a new property . . . of a previously known composition, even when that property . . . [is] unobvious from the prior art, can not impart patentability to claims to the known composition." *In re Spada*, 911 F.2d 705, 708 ((Fed. Cir. 1990).

The other properties discussed by Appellants are not required by claim 1. Further, Appellants have not shown in this record that these other properties are necessarily possessed by the scope of polylactic acid fibers encompassed by claim 1. As correctly explained by the Examiner, the Specification data, referred to by Appellants as showing these other properties, are not commensurate in scope with claim 1 (Ans. 14). To the

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extent that Appellants consider these properties to be unexpected (App. Br. 17), we remind Appellants that a showing of unexpected results sufficient to overcome a prima facie case of obviousness must be commensurate in scope with the claims. *See In re Peterson*, 315 F.3d 1325, 1330-31 (Fed. Cir. 2003).

For the reasons stated above and in the Answer, we sustain the Examiner's § 103 rejections of all appealed claims.

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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